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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809
Party	Defendant Nalge Nunc International Corporation Nalge Nunc International Corporation 75 Panorama Creek Drive Rochester, NY 146020365
Correspondence Address	DONALD F. FREI WOOD, HERRON & EVANS, L.L.P. 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202-2917
Submission	Reply in Support of Motion
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Signature	/Brett A. Schatz/
Date	05/08/2006
Attachments	Applicant Reply in Support Motion to Compel.pdf ( 9 pages )(484278 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF: Serial No. 76/572,253

TriForest Enterprises, Inc.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91165809
	)	Application No. 76572253
Nalge Nunc International Corporation,	)	Mark: plastic water bottle (design only)
	)	
Applicant.	)	
	)	

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**APPLICANT'S REPLY IN SUPPORT OF MOTION TO COMPEL**

**I. INTRODUCTION**

Through its Motion to Compel, Applicant seeks responses to specific Interrogatories and Document Requests to which Opposer has failed to adequately respond, despite Opposer's previous agreement to do so and its admission that Applicant's discovery requests are relevant to this Opposition. In fact, much of the discovery Applicant requests seeks information relevant to and supportive of Applicant's position that its mark is not functional, and is therefore particularly relevant to Applicant's preparation of its response to Opposer's pending Motion for Summary Judgment.<sup>1</sup>

Opposer argues that Applicant's Motion to Compel should be denied because Opposer's pending Motion for Summary Judgment will allegedly render the instant Motion to Compel moot. Opposer's argument puts the proverbial cart before the horse and illogically fails to recognize, perhaps intentionally, that the discovery sought by Applicant is relevant to and necessary for Applicant's response to Opposer's Motion for Summary Judgment. Regardless, the

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<sup>1</sup> So that Applicant is able to fully respond to Opposer's Motion for Summary Judgment, Applicant's response will include a request pursuant to Rule 56(f) for the discovery sought through Applicant's Motion to Compel.

fact that Opposer has filed a Motion for Summary Judgment is not a valid excuse for failing to respond to relevant discovery requests. Therefore, Applicant's Motion to Compel should be granted.

## **II. ARGUMENT**

### **A. Applicant's Discovery Requests Are Relevant To This Opposition and Opposer's Motion for Summary Judgment**

In its Motion to Compel, Applicant identified the specific Interrogatories to which Opposer has yet to adequately respond. (*See* Motion to Compel, pp. 2, 5). In addition, Opposer has not adequately responded to any of Applicant's Document Requests.<sup>2</sup> Each of these discovery requests seeks information that is relevant to this Opposition. In particular, these discovery requests seek information that is relevant to Applicant's position that its mark is not functional. Indeed, Opposer concedes that Applicant's discovery requests are relevant. (*See* Opposer's Opposition, mislabeled as a "Reply," p. 4).

For example, Applicant requested Opposer to identify its marketing, advertising, and promotional materials for its water bottles that bear Applicant's Bottle Configuration or a similar configuration. (*See* Interrogatory No. 16). Opposer's marketing, advertising, and promotional materials may demonstrate that Opposer touts the aesthetic features of its water bottles, thereby undermining Opposer's argument that such features are functional. *See New England Butt Co. v. Int'l Trade Comm'n*, 756 F.2d 874, 878-879 (Fed. Cir. 1985)(evaluation of advertising brochures and catalogs necessary to determine if such materials promote utilitarian features, or whether nonfunctional features are emphasized). Applicant also requested Opposer to identify the costs associated with the manufacture of its products. (*See* Interrogatory No. 18). Such costs are directly relevant to the issue of functionality in that they may reveal that Opposer's manufacturing is simpler and cheaper than that of Applicant. *See In re Morton-*

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<sup>2</sup> Opposer did produce a few documents on a CD; however, no documents have been produced that are responsive to

*Norwich Products, Inc.*, 671 F.2d 1332, 1341 (C.C.P.A. 1982)(In determining whether a container configuration is functional, the court noted that “[i]t is also significant that a particular design results from a comparatively simple or cheap method of manufacturing the article.”)

Applicant’s Document Requests, none of which have been adequately answered by Opposer, also seek information relevant to this Opposition. For example, Document Request No. 6 seeks information regarding Opposer’s target consumers and ordinary purchasers of Opposer’s water bottles. This information is relevant at least to Applicant’s assertion that consumers identify it with its mark, and is likely to lead to evidence related to consumers’ perception of the aesthetic nature of its Bottle Configuration. Applicant also requested documents related to Opposer’s advertising and promotion, intended advertising and promotion, and marketing or business plans, related to Opposer’s water bottles. As noted above, this information may undermine Opposer’s argument that Applicant’s mark is functional.

In sum, Applicant’s discovery requests are directly relevant to this case. Opposer concedes in its Opposition that at least some of Applicant’s discovery requests are relevant. (*See* Opposer’s Opposition, p. 4). In fact, Opposer tacitly conceded the relevancy of Applicant’s Document Requests by responding to every one that Opposer would produce responsive documents, without any objection as to relevancy: “Opposer will produce all responsive documents to the extent that they are available and not attorney client privileged, confidential trade secrets, attorney work product privileged, or otherwise privileged or confidential.” Therefore, Opposer agreed to produce all documents responsive to Applicant’s Document Requests, subject to privilege issues. In doing so, Opposer also waived any objection it had to Applicants’ Document Requests, including any objection based on a perceived lack of relevancy. *Keith H. v. Long Beach Unified School Dist.*, 228 F.R.D. 652, 657 (C.D. Cal. 2005)(“defendants

waived any relevancy objections by failing to raise them in a timely response to plaintiff's document requests...")

Despite agreeing to produce all responsive documents, and having waived any objection to Applicant's Document Requests, Opposer has failed to produce virtually anything. Applicant submits that Opposer should be ordered to do so, especially considering the relevancy of Applicant's discovery requests.

### **B. Opposer Had Timely Notice Of Its Deficient Discovery Responses**

As noted above, Opposer agreed it would produce all documents responsive to Applicant's Document Requests. Therefore, Applicant originally had little reason to demand responses to its discovery requests, as Applicant assumed such responses would be provided by Opposer, as agreed. Opposer concedes in its Opposition that on March 27, 2006, two days before the commencement of the first testimony period<sup>3</sup>, counsel for Applicant sent a letter to counsel for Opposer advising Opposer that adequate responses to Applicant's discovery requests had not yet been provided, and requesting that such responses be provided. The following day, on March 28, 2006, counsel for Applicant and Opposer discussed Opposer's insufficient discovery responses, in substantial compliance with 37 C.F.R. 2.120(e). (*See* Opposer's Opposition, p. 4). The very next day, Applicant served on Opposer the instant Motion to Compel, with a Certificate of First Class Mail.<sup>4</sup> Therefore, Opposer had notice before the commencement of the first testimony period that Applicant viewed Opposer's discovery responses as deficient. Opposer should not be heard to argue that Applicant's Motion to Compel was served only one day late.

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<sup>3</sup> The first testimony period began on March 29, 2006.

<sup>4</sup> Applicant's Motion to Compel included a Certificate of Service, demonstrating that the Motion to Compel was served by Federal Express, Two-Day Delivery, to Opposer on March 29, 2006. Counsel for Applicant concedes that the service date is the first day of the first testimony period. Counsel for Applicant simply miscalculated the Motion to Compel deadline, resulting in the one-day disparity. In addition, the zip code for the address of counsel for Opposer was incorrect. As noted herein, Applicant remedied the incorrect zip code immediately upon receiving notice, and provided Opposer with two additional weeks within which to respond.

Rather sharply, Opposer conveniently failed to bring to the Board's attention in its Opposition to Applicant's Motion to Compel that, immediately after Opposer notified Applicant that the Motion to Compel was not received by Federal Express, Applicant provided Opposer with two additional weeks to respond. (See Exhibit 9, attached hereto). Opposer also failed to inform the Board that Applicant resent the instant Motion to Opposer, by Federal Express. (See Exhibit 10, attached hereto).

Opposer also cites falsely to 37 C.F.R. 2.120(e) and *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolletoducate SCRL* for the proposition that "the beginning of discovery activity such as serving a notice of deposition cuts off the right to file discovery motions." (See Opposer's Opposition, p. 3). Contrary to Opposer's representation to the Board, neither 37 C.F.R. 2.120(e) nor *Societa Per Azioni* stands for this proposition, and Opposer's reference to them is incorrect. More disturbingly, Opposer refers to *Societa Per Azioni* and summarizes it as "untimely motion to compel denied." (See Opposer's Opposition, p. 3). Opposer's summary is entirely incorrect. In fact, a motion to compel was never filed in *Societa Per Azioni*, and the Board did not deny a motion to compel in that case.

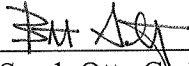
### **III. CONCLUSION**

Applicant's discovery requests seek information directly relevant to this Opposition, as well as to Applicant's response to Opposer's Motion for Summary Judgment. Indeed, Opposer conceded this fact in its Opposition. Opposer also previously agreed to produce all documents responsive to Applicant's Document Requests, thereby waiving any objection based on a perceived lack of relevancy. In addition, counsel for Opposer and Applicant discussed Opposer's deficient discovery responses before the commencement of the first testimony period in compliance with 37 C.F.R. 2.120(e), and Applicant served the Motion to Compel on the first day of the first testimony period. Therefore, Applicant submits that its

Motion to Compel should be granted, and Opposer should be ordered to fully respond to Applicant's discovery requests.

Respectfully submitted,  
Nalge Nunc International Corporation

Date: May 8, 2006


  
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Attorneys for Applicant,  
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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Trademark Trial and Appeal Board on the date shown below.

Date: May 8, 2006

  
\_\_\_\_\_  
Anita L. Freeman

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **APPLICANT'S REPLY IN SUPPORT OF MOTION TO COMPEL** was served by e-file copy and by Federal Express, Two-Day Delivery, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 8th day of May, 2006.

Nalge Nunc International Corporation



\_\_\_\_\_  
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Attorney for Applicant,  
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## SARAH OTTE GRABER

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**From:** SARAH OTTE GRABER  
**Sent:** Tuesday, April 11, 2006 10:10 AM  
**To:** 'law@clemcheng.com'  
**Cc:** BRETT SCHATZ; ANITA FREEMAN  
**Subject:** RE: Trademark Opposition No. 91165809 TriForest V. Nalg Nunc International

Dear Mr. Cheng,

In response to your request below, I will agree to allow you 14 days from yesterday's date to answer our Motion to Compel, despite your having adequate notice that we were going to file the motion prior to its filing date, March 29, 2006. We will look to receive your response no later than April 25, 2006.

Regards,

Sarah Otte Graber  
Wood, Herron & Evans, LLP  
2700 Carew Tower  
Cincinnati, OH 45202  
p-513.241.2324  
f- 513.241.6234  
[sgrab@whepatent.com](mailto:sgrab@whepatent.com)

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**From:** Clement Cheng [<mailto:law@clemcheng.com>]  
**Sent:** Monday, April 10, 2006 2:39 PM  
**To:** Sarah Otte Graber  
**Subject:** RE: Trademark Opposition No. 91165809 TriForest V. Nalg Nunc International

Ms. Graber:

Thank you for emailing me the files. I have received them. You have my zip code incorrect. It is 92708, and not 92703. If you check the tracking number on [fedex.com](http://fedex.com) it does not resolve and does not seem to be a valid tracking number. That's why the motion to compel was never served. Please agree to allow me 14 days from today to prepare a response.

Clement Cheng, Esq.  
Newhope Law, PC  
17220 Newhope St Ste 127  
Fountain Valley, CA 92708-4283  
Phone (714) 825-0555; Fax (714) 825-0558

Please reply to [law@clemcheng.com](mailto:law@clemcheng.com)

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**From:** Sarah Otte Graber [<mailto:sgrab@whepatent.com>]  
**Sent:** Monday, April 10, 2006 5:44 AM  
**To:** law

**SARAH OTTE GRABER**

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**From:** SARAH OTTE GRABER  
**Sent:** Monday, April 10, 2006 8:44 AM  
**To:** 'law@clemcheng.com'  
**Subject:** RE: Trademark Opposition No. 91165809 TriForest V. Nalg Nunc International

Dear Mr. Cheng,

As you can see from the attached email, my assistant sent our Motion to Compel to you last week before we spoke. We will fax you a copy and will also send you a hard copy via FedEx, in case your fax machine does not output properly.

Sarah Otte Graber  
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**From:** Clement Cheng [mailto:law@clemcheng.com]  
**Sent:** Friday, April 07, 2006 5:39 PM  
**To:** Sarah Otte Graber  
**Subject:** RE: Trademark Opposition No. 91165809 TriForest V. Nalg Nunc International

Dear Sara Graber,

I spoke to my client and he said will be available in the fall. Therefore, I do not have any concerns about his availability. Please prepare a stipulation for my signature so that we can take the deposition off calendar.

Having both of the motions resolved should take care of the case. The opposer is confident that the motion for summary judgment will dispose of the case. Also, applicant makes a valid point that the discovery matters should be resolved before a deposition.

The board should receive the stipulation well.

Please have a good weekend and don't forget to contact me on Monday.

Clement Cheng, Esq.  
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